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ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST P.A.
1401 CITRUS CENTER 255 SOUTH ORANGE AVENUE
P.O. BOX 3791
ORLANDO, FL 32802-3791

EXAMINER

BLAIR, DOUGLAS B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/596,629
Filing Date: June 19, 2000
Appellant(s): CHAPMAN ET AL.

Michael W. Taylor (Reg. No. 43,182)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/11/2008 appealing from the Office action mailed 5/9/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,377,355	HAGER et al.	12-1994
5,781,901	KUZMA	7-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 11-19, 21-28, 30-39, 41-49, 51-58, 60-68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,377,355 to Hager et al. in view of U.S. Patent Number 5,781,901 to Kuzma.

Hagar teaches the invention substantially as claimed (As in claim 52) including an intranet embodied on a computing device comprising a plurality of software modules for distributing an invention disclosure, the intranet having a plurality of users enrolled therein, each of the plurality of users having associated personnel information stored within the intranet (col. 5, lines 1-15), the intranet comprising: a software module for accessing an invention disclosure template form over the intranet; a software module for accessing an invention disclosure template form, the invention disclosure being created by an inventor and including information about an invention; a software module for selecting an option in the invention disclosure template form to include an attachment with the invention disclosure; a software module for submitting the invention disclosure over the intranet (col. 4, lines 40-61); a software module for creating a profile of the invention disclosure based upon a technical area relating to the invention disclosure in response to accessing associated personnel information of the inventor (col. 4, lines 62-67 and col. 5, lines 1-15); a software module for transmitting first notification message via e-mail to a first group of users based upon the created profile, the first group of users being within the plurality of users (col. 4, lines 62-67 and col. 5, lines 1-15); a software module for transmitting a second notification message via e-mail to a second group of users based upon the created profile, the second group of user being within the plurality of users and including a technical review coordinator (col. 6, lines 17-34); a software module for selecting at least one evaluator by the technical review coordinator (col. 9, lines 66-68 and col. 10, lines 1-9); a

software module for transmitting a third notification message via e-mail to the at least one evaluator (col. 6, lines 17-34); a software module for submitting evaluation comments by the at least one evaluator (col. 7, lines 5-42); an software module for submitting a recommendation of the invention disclosure by the technical review coordinator based upon the evaluation comments (col. 9, lines 37-57); and a software module for transmitting the recommendation of the invention disclosure via e-mail to the first and second group of users (col. 10, lines 29-58); however Hagar does not teach including an attachment to the invention disclosure created separately from the invention disclosure nor e-mailing a hyperlink to the document.

Official notice is taken that it was well known in the art at the time of the invention to send a hyperlink to a document instead of an entire document. Kuzma illustrates this fact in col. 4, line 65-col. 5, line 24.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure with the idea of sending a hyperlink instead of an entire document because sending only a hyperlink reduces the size of e-mails that would be sent, thus reducing network traffic.

Kuzma teaches a software module comprising instruction for including an attachment to a document the attachment having been created separate from the document (col. 4, line 65-col. 5, line 24). Kuzma further teaches a software module for attaching a file to an email without the use of a hyperlink, the file being created by the inventor separate from the email and including information about the invention that is not included in the email (col. 1, lines 22-30).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hager regarding a system for distributing an invention disclosure via email with the teachings of Kuzma regarding creating an attachment separately from an email document because creating and sending an attachment separately from a document saves network resources (Kuzma, col. 1, lines 22-50). However the Hager-Kuzma combination does not explicitly teach a software module for attaching a file to the invention disclosure without the use of a hyperlink, the file being created by the inventor separate from the invention disclosure and including information about the invention that is not included in the invention disclosure.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine teachings of the Hager-Kuzma combination regarding the separate creation of an attachment with the idea that the attachment is not attached with a hyperlink but rather is just attached because it is obvious to omit an element if the element's function is not required (See MPEP section 2144.04). In other words, it would have been obvious to just plain attach a Word or Powerpoint document as argued by the applicant rather than attach a hyperlink to such a document (See Kuzma, col. 1, lines 22-34). Either way, the attachment requires some form of link, otherwise one would never know that it is there.

As to claims 53, Hager teaches an intranet wherein the software module for transmitting the first notification message is responsive to submission of the invention disclosure (col. 4, lines 62-67 and col. 5, lines 1-15).

As to claim 54, Hager teaches an intranet wherein the software module for transmitting the second notification message is responsive to submission of the invention disclosure (col. 6, lines 17-34).

As to claim 55, Hager teaches an intranet wherein the profile comprises a functional manager of the inventor, a patent attorney, and technical review person (col. 5, lines 33-41).

As to claim 56, Hager teaches a profile comprising information relating to the inventor including the inventor's employee number, department number, building number, phone number and e-mail address (col. 4, lines 62-67 and col. 5, lines 1-15).

As to claim 57, Hager teaches an intranet wherein the first group of user comprises a business area manager, a supervisor of the inventor, and the inventor (col. 4, lines 62-67 and col. 5, lines 1-15).

As to claim 58, Hager teaches an intranet wherein the second group of users comprises a technical review coordinator, a contract administrator if the invention was developed under government funds, and an intellectual property administrator (col. 7, lines 32-42).

As to claim 59, Hager teaches a software module for creating an invention disclosure further comprising instructions for including an attachment (col. 4, lines 40-61).

As to claim 60, Hager teaches a software module for creating an invention disclosure comprising instructions for sending a notification message to a co-inventor (col. 4, lines 40-61). For reasons discussed above it would have been obvious to include a hyperlink in this message.

As to claims 1-11, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

As to claims 12-21, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

As to claims 22-30, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

As to claims 31-41, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

As to claims 42-51, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

As to claims 61-70, they feature the same limitations as claims 52-60 and are thus rejected on the same basis as claims 52-60.

(10) Response to Argument

On page 21 of the Appeal Brief, the Appellant argues that, "Hager et al. thus fails to teach or suggest providing options to the inventor when creating an invention disclosure, wherein a file describing the invention can be attached to the invention disclosure without the use of a hyperlink, as recited in the claimed invention" and "Hager et al. simply fails to provide options to the inventor when creating an invention disclosure".

In response to the Appellant's first point, the Examiner agrees that Hager does not explicitly teach an option for attaching a file without a hyperlink. Hager was not relied upon to show this feature. Kuzma was relied upon to show that these features were obvious. The following, from page 14, lines 14-24, is the extent of the Appellant's disclosure on the subject:

Yet another option available to the primary inventor is to include an attachment. Attachments, such as word documents, power point presentations, etc, can be attached to the invention disclosure. The primary

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inventor selects the appropriate option as shown in display portion 90 in FIG. 11 to obtain a display for adding attachments, as shown in FIGS. 16-20. The primary inventor selects a file on his individual computer 18 and uploads the file to the server 12. Attachments can be made until the invention disclosure is submitted.

The Appellant's disclosure makes it clear that the Appellant is doing nothing more than adding attachments (Such as Word documents and Power Point presentations) to email. Clearly the Appellant did not invent the concept of adding attachments to email (As illustrated at minimum by the cited portions of Kuzma, col. 1, lines 21-29). Given that the Appellant's disclosure does not provide any details that were not completely well known, the idea of adding an attachment to an email is not novel.

With respect to the argument that Hager simply fails to provide options to the inventor, the Examiner points out that the applicant only generically discloses the claimed "options" as illustrated in page 14, lines 14-24 of the Appellant's specification. The Kuzma reference renders the claimed "options" obvious because the fact that Kuzma allows attachments to be included with emails means that Kuzma is providing "options" to attach attachments to the emails. This interpretation is consistent with the Appellant's broad disclosure on the subject. If the appellant were to receive a patent for providing "options" for attaching to an email, what new piece of information would the public be receiving in return from the Appellant's disclosure? The Appellant does not appear to disclose any details about how an "option" is provided, thus the claim can only be interpreted in a broad manner.

From pages 22 to 23, the Appellant argues that, "the present invention recites that the file is attached to the invention disclosure without the use of a hyperlink." In response, the Examiner points out that Kuzma teaches the concept of adding attachments to emails without hyperlinking the attachments in the Background of Kuzma. The Background of Kuzma explains that

attachments can be directly attached to emails but it may be better to only include hyperlinks because hyperlinks conserve bandwidth. Kuzma renders obvious the both the concepts of attaching attachments to emails with and without hyperlinks. Because the Appellant's disclosure provides no technical details to differentiate the Appellant's claimed concept of adding attachments from the concepts taught by Kuzma, the Appellant's claims are obvious in view of Kuzma.

On page 23 the Appellant concludes by arguing the following:

Consequently, since Kuzma discloses that a hyperlink is used to attach a file to an e-mail, there is simply no motivation to selectively combine the references as suggested by the Examiner. It thus appears that the Examiner is using impermissible hindsight reconstruction to modify the Hager et al. patent in view of the Kuzma patent in an attempt to produce the claimed invention. The prior art references, individually or in combination, do not teach or suggest 1) selecting an option in an invention disclosure template form to include an attachment with the invention disclosure, and 2) attaching a file to the invention disclosure without the use of a hyperlink, wherein the file is created by the inventor separate from the invention disclosure and includes information about the invention that is not included in the invention disclosure.

In response, the Examiner maintains that Kuzma reads on the Appellant's broad concept of providing an "option" for the reasons discussed previously in this Examiner's Answer and Kuzma clearly shows that attaching a file to an email is not a novel concept. To summarize the rejection of the claims, Hagar is relied upon to show that the concept of collaborating on an invention disclosure document via a network using email is obvious. Kuzma is relied upon to show that attaching files to emails, with or without hyperlinks, is a well known concept. Because the Appellant's disclosure does not provide any technical details aside from what is well known in the art, the Appellant's claimed invention is obvious as illustrated in the Hagar-Kuzma rejection and therefore the rejections of the Appellant's claims should be affirmed.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Douglas B Blair/

Examiner, Art Unit 2142

Conferees:

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145